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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/512,073	09/13/2005	Satoshi Kitani	256900US6X PCT	2795

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OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, L.L.P.  
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ALEXANDRIA, VA 22314

EXAMINER
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JONES, HEATHER RAE

ART UNIT	PAPER NUMBER
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2481

NOTIFICATION DATE	DELIVERY MODE
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01/12/2011

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/512,073	<b>Applicant(s)</b> KITANI ET AL.	
	<b>Examiner</b> HEATHER R. JONES	<b>Art Unit</b> 2481	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 1-7 and 41-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/5/04,12/18/06,4/10/07,9/14/07</u> .                        | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of claims 8-40 in Group II in the reply filed on September 20, 2010 is acknowledged.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 8-13 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Said claims disclose a "recording medium" (line 1). Both said claim and the respective specification ("On one recording medium such as a DVD (Digital Versatile Disc)..." - p. 1, ll. 12-15; "Alternatively, the present invention can be applied to another reproduction-only recording medium such as a magnetic disc, a magneto-optical disc, an optical card, or a memory card." - p. 85, ll. 22-25) fail to disclose whether said "recording medium" is limited to a non-transitory medium or transitory propagating signal. Reading said claim under the broadest reasonable interpretation "recording medium" is considered to read on a transitory propagating signal. See the Subject Matter Eligibility of Computer Readable Media memo dated February, 23 2010 (1351 OG 212). A claim directed to only signals per se is not a process, machine, manufacture, or composition of matter and therefore is not directed to statutory subject matter. See MPEP § 2106. Thus, both said claim and said

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specification fail to define said "recording medium" to be statutory media. The Examiner suggests amending the claim to "non-transitory recording medium".

3. The method claims 14-29 and 40 are considered to be statutory because they are inherently tied to an apparatus because a human could not perform recording of video content without the aid of a machine. The apparatus claims 30-39 are considered to be statutory because the specification does not disclose that the apparatus can be implemented solely using software.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohmori et al. (U.S. Patent 7,353,543) in view of Katoh (U.S. Patent 6,779,044).

Regarding claim 8, Ohmori et al. discloses a recording medium on which data of a video content is recorded (Fig. 3) and a medium identification information (bind key) (Fig. 3 - medium identification information is the bind key), the medium identification information (bind key) uniquely identifying each of recording mediums (Fig. 3; col. 5, lines 39-42 - the bind key is a randomly generated number for each DVD), the medium revocation list designating a recording medium to be revoked with at least the medium identification

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information or an identification message necessary for assuring the trueness of the medium identification information (col. 6, lines 42-57 - Black List (222) - identifies illegal recording media on which illegal content that is illegally copied main content is recorded). Ohmori et al. discloses the medium revocation list on the apparatus (Figs. 4 and 5). However, Ohmori et al. still fails to disclose that the medium revocation list is recorded on the recording medium.

Referring to the Katoh reference, Katoh discloses a recording medium on which data of a video content is recorded wherein a revocation list is recorded on the recording medium (col. 8, lines 1-5 - a revocation list is recorded on the recording medium (20)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have recorded the revocation list on the recording medium as disclosed by Katoh in the medium disclosed by Ohmori et al. in order to easily provide the revocation list to any device the recording medium comes into contact with to ensure validity of the content.

Regarding claim **9**, Ohmori et al. in view of Katoh discloses all of the limitations as previously discussed with respect to claim 8 including that the identification message is obtained from the medium identification information using a one-directional function (Ohmori et al.: col. 10, lines 40-55 - the encrypted data is decrypted and read by the main player (300), it is a one-directional function because this information is not changed by the main player and there to be read only).

Regarding claim **10**, Ohmori et al. in view of Katoh discloses all of the limitations as previously discussed with respect to claim 8 including that the medium identification information is successive for recording mediums and unique thereto (Ohmori et al.: col. 5, lines 25-37 - the main content has key information unique to that title), and wherein the medium revocation list designates a recording medium to be revoked with the title information of the video content and the identification message (Ohmori et al.: col. 6, lines 42-58 - black list (222)).

Regarding claim **11**, Ohmori et al. in view of Katoh discloses all of the limitations as previously discussed with respect to claim 8 including that the medium identification information is not successive for recording mediums and is unique thereto (Ohmori et al.: col. 5, lines 39-42), and wherein the medium revocation list designates a recording medium to be revoked with the medium identification information (Ohmori et al.: col. 6, lines 42-58 - black list (222)).

Regarding claim **12**, Ohmori et al. in view of Katoh discloses all of the limitations as previously discussed with respect to claim 8 including that the medium revocation list has version information (Katoh: col. 8, lines 1-4; col. 9, lines 22-27 - the revocation list gets updated).

Regarding claim **13**, Ohmori et al. in view of Katoh discloses all of the limitations as previously discussed with respect to claim 8 including that a device revocation list that designates a device to be revoked is also recorded (Ohmori et al.: device revocation list (223); Katoh: col. 8, lines 1-5).

Regarding claim **14**, Ohmori et al. discloses a recording medium producing method for producing a recording medium on which data of a video content is recorded, the method comprising the steps of: editing the data of the video content (col. 5, lines 11-37 - when the content is recorded it includes encryption data, hash marks, and a bind key that has been edited into the information); the medium identification information (bind key) uniquely identifying each of recording mediums (Fig. 3; col. 5, lines 39-42 - the bind key is a randomly generated number for each DVD), the medium revocation list designating a recording medium to be revoked with at least the medium identification information or an identification message necessary for assuring the trueness of the medium identification information (col. 6, lines 42-57 - Black List (222) - identifies illegal recording media on which illegal content that is illegally copied main content is recorded); and recording the medium identification information for each medium in accordance with other than a recording method for the data of the video content (col. 5, lines 25-42). Ohmori et al. discloses the medium revocation list on the apparatus (Figs. 4 and 5). However, Ohmori et al. still fails to disclose that the medium revocation list is recorded on the recording medium.

Referring to the Katoh reference, Katoh discloses a recording medium on which data of a video content is recorded wherein a revocation list is recorded on the recording medium (col. 8, lines 1-5 - a revocation list is recorded on the recording medium (20)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have recorded the revocation list on the recording medium as disclosed by Katoh in the medium disclosed by Ohmori et al. in order to easily provide the revocation list to any device the recording medium comes into contact with to ensure validity of the content.

Regarding claim **15**, grounds for rejecting claim 9 apply for claim 15 in its entirety.

Regarding claim **16**, grounds for rejecting claim 10 apply for claim 16 in its entirety.

Regarding claim **17**, grounds for rejecting claim 11 apply for claim 17 in its entirety.

Regarding claim **18**, grounds for rejecting claim 12 apply for claim 18 in its entirety.

Regarding claim **19**, grounds for rejecting claim 13 apply for claim 19 in its entirety.

Regarding claim **20**, Ohmori et al. discloses a reproducing method for a recording medium on which data of a video content is recorded, medium identification information (bind key) (Fig. 3 - medium identification information is the bind key), the medium identification information uniquely identifying each of recording mediums (Fig. 3; col. 5, lines 39-42 - the bind key is a randomly generated number for each DVD), the medium revocation list designating a recording medium to be revoked with at least the medium identification



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information or an identification message necessary for assuring the trueness of the medium identification information (col. 6, lines 42-57 - Black List (222) - identifies illegal recording media on which illegal content that is illegally copied main content is recorded), the method comprising the steps of: reading the medium identification information (Fig. 9 - steps S121 and S122); reading the medium revocation list (Fig. 9 - steps S124 and S125); storing the medium identification information that has been read or the identification message of the medium identification information to a memory (Fig. 10 - S136 - the information is stored in memory (309)); determining whether or not the medium identification information or the identification message that has been stored is contained in the medium revocation list (Fig. 9 - steps S124 and S125); and restricting a reproducing operation for the recording medium when the determined result at the medium list determining step represents that the recording medium should be revoked (Fig. 9 - steps S127 and S126). Ohmori et al. discloses the medium revocation list on the apparatus (Figs. 4 and 5). However, Ohmori et al. still fails to disclose that the medium revocation list is recorded on the recording medium.

Referring to the Katoh reference, Katoh discloses a recording medium on which data of a video content is recorded wherein a revocation list is recorded on the recording medium (col. 8, lines 1-5 - a revocation list is recorded on the recording medium (20)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have recorded the revocation list on the

recording medium as disclosed by Katoh in the medium disclosed by Ohmori et al. in order to easily provide the revocation list to any device the recording medium comes into contact with to ensure validity of the content.

Regarding claim **21**, Ohmori et al. in view of Katoh discloses all of the limitations as previously discussed with respect to claim 20 including that the medium revocation list has version information (Katoh: col. 8, lines 1-4; col. 9, lines 22-27 - the revocation list gets updated).

Regarding claim **22**, Ohmori et al. in view of Katoh discloses all of the limitations as previously discussed with respect to claims 20 and 21 including that the method further comprises the step of: updating the medium revocation list with a copyright managing server connected to a device to be restricted for its reproducing operation through a network (Katoh: col. 8, lines 1-4; col. 9, lines 22-27 - the revocation list gets updated through the internet).

Regarding claim **23**, Ohmori et al. in view of Katoh discloses all of the limitations as previously discussed with respect to claim 20 including that a device revocation list designating a illegal device to be revoked is recorded on the recording medium (Katoh: col. 8, lines 1-5), and wherein the reproducing method further comprises the steps of: reading the device revocation list (Katoh: Fig. 4 - step S2); storing the device revocation list that has been read (Katoh: Fig. 4 - step S5 and S8); determining whether or not a device that is reproducing data is contained in the device revocation list (Katoh: Fig. 4 - step S4); and restricting a reproducing operation of the device for the recording medium when the

determined result at the device list determining step represents that the device should be revoked (Kato: Fig. 4 - step S3).

Regarding claim **24**, Ohmori et al. in view of Kato discloses all of the limitations as previously discussed with respect to claims 20 and 23 including that the method further comprises the step of: updating the medium revocation list with a copyright managing server connected to a device to be restricted for its reproducing operation through a network (Kato: col. 8, lines 1-4; col. 9, lines 22-27 - the revocation list gets updated through the internet).

Regarding claim **25**, Ohmori et al. discloses a reproducing method for a recording medium on which data of a video content is recorded, medium identification information (bind key) is recorded on the recording medium (Fig. 3 - medium identification information is the bind key), the medium identification information uniquely identifying each of recording mediums (Fig. 3; col. 5, lines 39-42 - the bind key is a randomly generated number for each DVD), the method comprising the steps of: reading the medium identification information (Fig. 9 - steps S121 and S122); a medium identification information storing the medium identification information that has been read or an identification message of the medium identification information to a memory (Fig. 5 - the information storage unit (309) stores the medium identification information); connecting a copyright manager server through a network (Fig. 4 - contents supply apparatus (200) is connected through a network using the transmission/reception unit (207)), receiving a medium revocation list (Fig. 9 - steps S124 and S125); storing the

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medium identification information that has been read or the identification message of the medium identification information to a memory (Fig. 10 - S136 - the information is stored in memory (309)); determining whether or not the medium identification information or the identification message that has been stored is contained in the medium revocation list (Fig. 9 - steps S124 and S125); and restricting a reproducing operation for the recording medium when the determined result at the medium list determining step represents that the recording medium should be revoked (Fig. 9 - steps S127 and S126). Ohmori et al. discloses the medium revocation list on the apparatus (Figs. 4 and 5). However, Ohmori et al. still fails to disclose that the medium revocation list is recorded on the recording medium.

Referring to the Katoh reference, Katoh discloses a recording medium on which data of a video content is recorded wherein a revocation list is recorded on the recording medium (col. 8, lines 1-5 - a revocation list is recorded on the recording medium (20)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have recorded the revocation list on the recording medium as disclosed by Katoh in the medium disclosed by Ohmori et al. in order to easily provide the revocation list to any device the recording medium comes into contact with to ensure validity of the content.

Regarding claim **26**, grounds for rejecting claim 21 apply for claim 26 in its entirety.

Regarding claim **27**, grounds for rejecting claim 22 apply for claim 27 in its entirety.

Regarding claim **28**, grounds for rejecting claim 23 apply for claim 28 in its entirety.

Regarding claim **29**, grounds for rejecting claim 24 apply for claim 29 in its entirety.

Regarding claims **30-34**, these are apparatus claims corresponding to the method claims 20-24. Therefore, claims 30-34 are analyzed and rejected as previously discussed with respect to claims 20-24.

Regarding claims **35-39**, these are apparatus claims corresponding to the method claims 25-29. Therefore, claims 35-39 are analyzed and rejected as previously discussed with respect to claims 25-29.

Regarding claim **40**, Ohmori et al. discloses a copyright managing method for a system of which a plurality of reproducing apparatuses and a copyright managing server authorized by a copyright supervisor are connected through a network (Fig 4. - contents supply apparatus (200) is connected through a network using the transmission/reception unit (207)), the copyright managing method comprising the steps of: causing each of the reproducing apparatuses to record data of a video content and reproduce data from each recording medium on which medium identification information that uniquely identifies the recording medium is recorded (Fig. 3; col. 5, lines 39-42 - the bind key is a randomly generated number for each DVD); causing each of the reproducing apparatuses

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to read the medium identification information from the recording medium and transmit an identification message obtained from the medium identification information using a one-directional function (col. 10, lines 40-55 - the encrypted data is decrypted and read by the main player (300), it is a one-directional function because this information is not changed by the main player and there to be read only); causing the copyright managing server to receive the device identification information and the identification message (Fig. 9 - step S124); causing the copyright managing server to determine whether or not the plurality of reproducing apparatuses have reproduced data from the same recording medium in accordance with a set of received data (Fig. 9 - step S127); and causing the copyright managing server to add at least the medium identification information or the identification information that designates the recording medium to the medium revocation list when a predetermined number of reproducing apparatuses have reproduced the same medium identification information from recording mediums (Fig. 10 - step S136 and Fig. 11 - step S143). However, Ohmori et al. still fails to disclose that the medium revocation list is recorded on the recording medium.

Referring to the Katoh reference, Katoh discloses a recording medium on which data of a video content is recorded wherein a revocation list is recorded on the recording medium (col. 8, lines 1-5 - a revocation list is recorded on the recording medium (20)).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have recorded the revocation list on the recording medium as disclosed by Katoh in the medium disclosed by Ohmori et al. in order to easily provide the revocation list to any device the recording medium comes into contact with to ensure validity of the content.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HEATHER R. JONES whose telephone number is (571)272-7368. The examiner can normally be reached on Mon. - Thurs.: 7:00 am - 4:30 pm, and every other Fri.: 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter-Anthony Pappas can be reached on 571-272-7646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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Heather R Jones  
Examiner  
Art Unit 2481

HRJ  
December 4, 2010

/Peter-Anthony Pappas/  
Supervisory Patent Examiner, Art Unit 2481